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| 10/808,754 | 03/25/2004 | Masahiro Hashimoto | 13726Z | 5870 |

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| EXAMINER | |
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| TRAN, PHUOC | |

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/808,754 | HASHIMOTO, MASAHIRO | |
| | Examiner | Art Unit | |
| | Phuoc Tran | 2624 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *11 October 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1,7 and 13* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,7 and 13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

1. Applicant's arguments filed 10/1/07 have been fully considered but they are not persuasive.

Applicant argue that Conover does not disclose or suggest changing a DCT coefficient in a block to produce modified coefficients and then correcting a level of a DCT coefficient from the modified DCT coefficients, except the changed DCT coefficients, to produce corrected DCT coefficients.

In reply, Conover teaches, at column 11, lines 32-37, that a watermark can be embedded into a compressed video bitstream by changing the sign of a DCT coefficient to produce changed DCT coefficients in an image block. Conover also teaches, at column 11, lines 37-43, and column 12, lines 38-45, that the magnitude of a coefficient in an image block (i.e., among changed DCT coefficients and inherently excluding the changed sign DCT coefficient) is modified so that the total code length remains the same.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 7 are rejected under 35 U.S.C. 102(e) as being anticipated by Conover et al (6,373,960).

Regarding claim 7, Conover et al disclose a method for inserting additional information in DCT coefficients by referring to a variable-length code table, wherein the DCT coefficients are generated in blocks from image data, the method comprising the steps of: inserting additional information into input DCT coefficients in a block by changing at least one DCT coefficient of the input DCT coefficients to produce changed DCT coefficients (col. 7, lines 55-67; col. 9, lines 27-38; col. 11, lines 32-43); and correcting a level of a DCT coefficient selected from the changed DCT coefficients in the block, excluding the at least one changed DCT coefficient, to produce corrected DCT coefficients by referring to the variable-length code table, the DCT coefficient selected so that a total code length of codes generated from the corrected DCT coefficients is equal to an original total code length of codes generated from the input DCT coefficients in the block (col. 9, lines 34-38; col. 10, lines 21-25; col. 11, lines 32-43, lines 51-56; col. 12, line 1-45; col. 16, lines 40-45; col. 17, lines 4-13).

In particular, Conover teaches, at column 11, lines 32-37, that a watermark can be embedded into a compressed video bitstream by changing the sign of a DCT coefficient to produce changed DCT coefficients in an image block. Conover also teaches, at column 11, lines 37-43, and column 12, lines 38-45, that the magnitude of a coefficient in an image block (i.e., among changed DCT coefficients and inherently excluding the changed sign DCT coefficient) is modified so that the total code length remains the same.

Conover further teaches, at column 11, lines 51-56, and column 17, lines 4-13, that a modified coefficient is corrected so that the total code length generated from the corrected DCT coefficients in an image block is identical to the total code length generated from the original DCT coefficients in the image block.

Claim 1 is simply directed to an apparatus corresponding to the method of claim 7. Conover et al show such apparatus in Figure 7 (i.e. Fig. 7, item 212; col. 14 lines 12-39).

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Conover et al.

Claim 13 is simply directed to a software implementation of the method of claim 7. Although Conover et al do not describe a recording medium storing a computer-readable program for implementing the method of claim 7, such software implementation would have been obvious to one of ordinary skill in the art. It is simply an obvious matter of design choice.

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1, 7, 13 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 6 of U.S. Patent No. 6,775,416. Although the conflicting claims are not identical, they are not patentably distinct from each other because the elements of claims 1, 7, are fully anticipated by patent claims 1, 6, and anticipation is "the ultimate or epitome of obviousness" (*In re Kalm*, 154 USPQ 10 (CCPA 1967), also *In re Dailey*, 178 USPQ 293 (CCPA 1973) and *In re Pearson*, 181 USPQ 641 (CCPA 1974)). Claim 13 is simply directed to a software implementation of the method of claim 7. Although patent claims 1, 6 do not recite a recording medium storing a computer-readable program for implementing the method of claim 7, such software implementation would have been obvious to one of ordinary skill in the art. It is simply an obvious matter of design choice.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuoc Tran whose telephone number is (571) 272-7399. The examiner can normally be reached on MON-FRI.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eileen D. Lillis can be reached on (571) 272-6928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.